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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,215	02/27/2004	Linlin Xing	FDN-2829	9090
7590 12/15/2008				
William J. Davis, Esq. GAF MATERIALS CORPORATION Legal Department, Building No. 10 1361 Alps Road Wayne, NJ 07470		EXAMINER COLE, ELIZABETH M		
		ART UNIT 1794		
		MAIL DATE 12/15/2008		
		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/789,215

**Applicant(s)**

XING ET AL.

**Examiner**

Elizabeth M. Cole

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 8, 11, 15, 21, are rejected under 35 U.S.C. 102(b) as being anticipated by Kielbania et al, U.S. Patent No. 5,945,473. Kielbania et al discloses a binder composition suitable for use as binder for fiberglass, (col. 8, lines 39-44), comprising a water based polyurethane which may be either aliphatic or aromatic, (col. 3, lines 20-21), and an additional polymer, such as urea formaldehyde, (col. 7, line 36), wherein the water based polyurethane is present in an amount of 5-75 weight percent and the binder is present in an amount of 0.5-60 weight percent. Kielbania teaches that the combination of the water based polyurethane and the resin binder such as urea formaldehyde improves the properties of the resulting polymeric resin blend. See col. 2, lines 47- col. 3, line 17. The polyurethane can be a carboxylated polyurethane. See col. 4, lines 1-col. 6, line 32.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kielbania et al, U.S. Patent No. 5,945,473 in view of Heine U.S. Patent No. 6,146,705. Kielbania et al discloses a binder composition suitable for use as binder for fiberglass, (col. 8, lines 39-44), comprising a water based polyurethane which may be either aliphatic or aromatic, (col. 3, lines 20-21), and an additional polymer, such as urea formaldehyde, (col. 7, line 36), wherein the water based polyurethane is present in an amount of 5-75 weight percent and the binder is present in an amount of 0.5-60 weight percent. Kielbania teaches that the combination of the water based polyurethane and the resin binder such as urea formaldehyde improves the properties of the resulting polymeric resin blend. See col. 2, lines 47- col. 3, line 17. Kielbania differs from the claimed invention because although Kielbania teaches using the resulting composition as a binder for use with glass fibers and fiberglass mats, Kielbania does not teach the particularly claimed fibers and amounts of fibers and binders, and does not specifically teach a roofing shingle material. Heine discloses a fibrous glass mat comprising fibers having a length of 1-1.5 inches and a diameter of 14-18 microns, (see col. 2, lines 35-44) which are bonded with a urea formaldehyde binder. The binder is present in an amount of 5-15% by weight. The mat can be used as a shingle and can have asphalt applied to it after formation. See col. 4, lines 1-27. It would have been obvious to one of ordinary skill in the art to have employed fibers having the size and in the amount taught by Heine in order to form a roofing material which is bonded with the binder composition of Kielbania, in order to take advantage of the improved properties which

are obtained by the mixture of the water based polyurethane and the urea formaldehyde as taught by Kielbania.

5. Applicant's arguments filed 10/7/08 have been fully considered but they are not persuasive. Applicant argues that Kielbania fails to teach a resinous fiber binder . However, Kielbania discloses a binder composition suitable for use as binder for fiberglass, (col. 8, lines 39-44), comprising a water based polyurethane which may be either aliphatic or aromatic, (col. 3, lines 20-21), and an additional polymer, such as urea formaldehyde, (col. 7, line 36), wherein the water based polyurethane is present in an amount of 5-75 weight percent and the binder is present in an amount of 0.5-60 weight percent. Kielbania teaches that the combination of the water based polyurethane and the resin binder such as urea formaldehyde improves the properties of the resulting polymeric resin blend. See col. 2, lines 47- col. 3, line 17.

6. Applicant argues that the PPE itself is not the same as the claimed resinous fiber binder. However, Applicant claims a resinous fiber binder. The PPE of Kielbania is a thermoplastic or thermosetting resin that can be part of an aqueous dispersion further comprising the water based urethane modifier. The composition can be used as a binder for fiberglass. Therefore, it is not clear in what way the binder composition or the PPE of Kielbania differs from the claimed invention.

7. Applicant argues that the claimed end uses of Kielbania are not even the same as the claimed fiber mat for use in a building material. However, Kielbania disclose the claimed components of a binder composition for use as a binder for fiberglass. In response to applicant's argument that the end uses of Kielbania are not the same as the

intended use of the instant invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

The examiner's supervisor Rena Dye may be reached at (571) 272-3186.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

/Elizabeth M. Cole/  
Primary Examiner, Art Unit 1794

e.m.c